

ESTTA Tracking number: **ESTTA207425**

Filing date: **04/26/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Blizzard Entertainment, Inc.
Granted to Date of previous extension	04/30/2008
Address	6060 Center Drive, 5th floor Los Angeles, CA 90045 UNITED STATES
Attorney information	Rod A. Rigole Vivendi Games, Inc. 6060 Center Drive, 5th floor Los Angeles, CA 90045 UNITED STATES terry.kiel@vgames.com Phone:310-431-4334

Applicant Information

Application No	77233112	Publication date	01/01/2008
Opposition Filing Date	04/26/2008	Opposition Period Ends	04/30/2008
Applicant	Cushing, Robert 18213 Mandarin St Woodland, CA 95695 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Hats; Jackets; Pants; Shirts; Sweat shirts

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2791742	Application Date	04/26/1996
Registration Date	12/09/2003	Foreign Priority Date	NONE
Word Mark	DIABLO		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 016. First use: First Use: 1997/01/29 First Use In Commerce: 1997/01/29 PAPER GOODS, NAMELY, COMIC BOOKS, STRATEGY GUIDES FOR PLAYING ENTERTAINMENT COMPUTER PROGRAMS IN THE NATURE OF ROLE-PLAYING ADVENTURE GAMES, TRADING CARDS, TRADING CARD MILK BOTTLE CAPS, COLORING BOOKS, ADHESIVE STICKERS, RUB-ON TRANSFERS, NOTEBOOKS AND STATIONERY-TYPE PORTFOLIOS</p> <p>Class 025. First use: First Use: 1996/12/13 First Use In Commerce: 1996/12/31 CLOTHING, NAMELY, PAJAMAS, HATS SWEATSHIRTS, T-SHIRTS, SHIRTS, SHOES, JACKETS, SHORTS, SOCKS AND SWEATERS</p> <p>Class 028. First use: First Use: 1996/11/12 First Use In Commerce: 1996/11/12 COMPUTER SOFTWARE GAMES; HANDHELD UNITS FOR PLAYING ELECTRONIC GAMES; TOYS, NAMELY, TOY ACTION FIGURES AND ACTION FIGURE ACCESSORIES</p>

U.S. Registration No.	2416001	Application Date	04/26/1996
Registration Date	12/26/2000	Foreign Priority Date	NONE
Word Mark	DIABLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/11/12 First Use In Commerce: 1996/12/30 ENTERTAINMENT COMPUTER PROGRAMS IN THE NATURE OF ROLE-PLAYING ADVENTURE GAMES		

U.S. Application No.	78770575	Application Date	12/09/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DIABLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use:</p> <p>ENTERTAINMENT SERVICES, NAMELY, PROVIDING ON-LINE COMPUTER AND VIDEO GAMES, ON-LINE PUBLICATIONS IN THE FIELD OF TIPS AND STRATEGIES FOR COMPUTER GAMES; ARRANGING AND CONDUCTING COMPUTER GAME COMPETITIONS; ENTERTAINMENT IN THE NATURE OF AN ONGOING TELEVISION PROGRAM IN THE FIELD OF CHARACTERS AND PLOTS BASED ON A VIDEO GAME; AND PRODUCTION AND DISTRIBUTION OF MOTION PICTURES</p>		

Attachments	<p>75978709#TMSN.gif (1 page)(bytes)</p> <p>78770575#TMSN.jpeg (1 page)(bytes)</p> <p>Notice of Opposition-DIABLO 999 PDF.pdf (10 pages)(82884 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/rod a rigole/
Name	Rod A. Rigole
Date	04/26/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Blizzard Entertainment, Inc.)	
)	
)	
Opposer,)	
)	
v.)	Opposition No. (to be assigned)
)	
Cushing, Robert, an Individual)	
Applicant.)	

ATTN: Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202

S i r and/or M a d a m:

NOTICE OF OPPOSITION

In the matter of the application of Cushing, Robert (“Applicant”) for registration of the trademark "DIABLO 999", application Serial No. 77/233,112 published in Part 4 of the USPTO Official Gazette of January 1, 2008; Blizzard Entertainment, Inc. (“Blizzard”), a corporation organized and existing under the laws of Delaware with a principal place of business at 6060 Center Drive, 5th floor, Los Angeles, California 90045, believes that it will be damaged by registration of the mark shown in Serial No. 77/233,112 and hereby opposes registration.

On January 16, 2008, during the initial period of opposition, Opposer Blizzard filed a First 30 Day Request for Extension of Time to Oppose which was request was granted, extending the opposition notice period to March 1, 2008. Opposer then sent a letter to Applicant notifying him of Opposer's opposition to the application for registration of DIABLO 999 and of Opposer's filing for a First 30 Day Extension of Time to Oppose and further inviting Applicant to engage in dialogue over Opposer's concerns.

On or about January 24, 2008, Opposer was contacted by Applicant, who stated that he would contact his attorney and revert to Opposer. On February 15, 2008 Opposer sent an e-mail inquiry to Applicant requesting a status update on the matter. Within hours, Applicant responded that, based on his attorney's advice, he was simply going to wait for Opposer to file a formal opposition. On February 21, 2008, Opposer filed a further 60 Day Request for Extension of Time to Oppose for Good Cause to allow for further time to investigate the claim and for additional time to confer with counsel. The extension was granted to April 30, 2008. Opposer then sent one final e-mail on February 21, 2008 to Applicant with a request for reconsideration of his position and to further encourage Applicant to discuss the issues so that a formal proceeding might be circumvented. Applicant responded promptly on February 22, 2008 informing Opposer of his understanding that a stalemate had been reached and no further discussions were warranted. For the record, please note that in his e-mail of February 22, 2008, Applicant makes mention of a request by Opposer for an extension of time and that he withheld such consent. The allegation is false. Opposer did not request (nor did Opposer require) consent from Applicant to file its 60 Day Request for Extension of Time to Oppose for Good Cause.

Consequently, and in consideration of the fact that negotiation attempts have been unsuccessful, this Notice of Opposition is being timely filed during this period of opposition.

The grounds for opposition are as follows:

1. Opposer, through its predecessors, business units and itself, has been engaged in the business of offering computer and video game software and related peripheral and promotional goods/services throughout the United States and internationally under the mark DIABLO. Opposer has used the mark DIABLO in interstate commerce on the aforementioned goods/services since at least as early as November 12, 1996.

2. Opposer is the owner of the following listed trademark application and registrations filed with the United States Patent and Trademark Office:

<u>Trademark</u>	<u>Status</u>	<u>Ser. No.</u>	<u>Reg. No.</u>	<u>Class(es)</u>	<u>App. Date</u>	<u>Reg. Date</u>
DIABLO	Registered	75/978,709	2,416,001	9	04/26/1996	12/26/2000
DIABLO	Registered	75/983,307	2,791,742	16, 25, 28	04/26/1996	12/09/2003
DIABLO	Allowed	78/770,575		41	12/09/2005	

Each listed registration is valid and subsisting and a copy of the respective registration certificates are attached hereto.

3. The use of Opposer's marks have been valid and in continuous since the dates of first use, and have not been abandoned. Opposer's marks are symbolic of extensive good will and consumer recognition built up by Opposer through substantial amounts of time and effort, together with substantial amounts of money expended for the purpose of advertising and promoting the goods and services related to Opposer's extensive use of the DIABLO trademarks for more than eleven (11) years.

4. Opposer, through its predecessors, business units, and itself, has created, developed, manufactured, distributed, sold, and otherwise exploited the trademark DIABLO through an expanding, popular, and award-winning series of action-oriented role-playing games (RPGs) as well as related peripheral and promotional merchandise including action figures, novels based on the games, and clothing such as hats, t-shirts, etc. In addition, Opposer has a film property under development that will further exploit its DIABLO trademark. The following details represent the main game products associated with the DIABLO brand name, and the year of their respective release.

<u>Game Title</u>	<u>Year</u>
DIABLO	1996
HELLFIRE (Single player DIABLO expansion pack)	1997
DIABLO/HELLFIRE bundle pack	1998
DIABLO II	2000
DIABLO II - Lord Of Destruction	2001
DIABLO II - BATTLE CHEST (contains all DIABLO games)	2001

It is important to note that Opposer maintains and regularly expands and upgrades the DIABLO series through its various on-line portals such as www.battle.net and www.blizzard.com to enhance and maintain play for game owners and subscribers to on-line services dedicated to interactive electronic gaming.

5. Notwithstanding Opposer's rights in and to its DIABLO mark, Applicant, on July 18, 2007, filed an application for registration of the mark DIABLO 999 for "Hats; Jackets; Pants; Shirts; Sweat shirts" in International Class 25. That application was assigned Serial No. 77/233,112 and published for opposition in the Official Gazette of January 1, 2008. As of this writing, Opposer has no information related to Applicant's use of the mark.

6. Applicant's mark DIABLO 999 contains Opposer's mark DIABLO in its entirety.

7. Applicant's mark DIABLO 999, when used in connection with the goods/services set forth in its application, is likely to cause confusion, mistake and deception and/or create a sense of endorsement, sponsorship, or false association with Opposer or Opposer's goods/services.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark, and prays that registration be denied.

Dated: April 26, 2008

Respectfully submitted,

Blizzard Entertainment, Inc.

/rod a rigole/
Rod A. Rigole
Attorney of Record
Vivendi Games, Inc.
6060 Center Drive, 5th floor
Los Angeles, CA 90045

e-mail: rod.rigole@vgames.com
Telephone: (310) 431-4334
Facsimile: (310) 431-2334

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served on this date upon all parties via e-mail to:

rlc75@sbcglobal.net

as well as by First Class Mail to:

Robert Cushing
18213 Mandarin Street
Woodland, CA 95695

Dated: April 26, 2008

Respectfully submitted,

Blizzard Entertainment, Inc.

/rod a rigole/
Rod A. Rigole
Attorney of Record
Vivendi Games, Inc.
6060 Center Drive, 5th floor
Los Angeles, CA 90045

Int. Cls.: 16, 25, and 28

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 39, and 50

United States Patent and Trademark Office

Reg. No. 2,791,742

Registered Dec. 9, 2003

**TRADEMARK
PRINCIPAL REGISTER**

DIABLO

DAVIDSON & ASSOCIATES, INC. (CALIFORNIA
CORPORATION)
6080 CENTER DRIVE
LOS ANGELES, CA 90045

FOR: PAPER GOODS, NAMELY, COMIC BOOKS,
STRATEGY GUIDES FOR PLAYING ENTERTAIN-
MENT COMPUTER PROGRAMS IN THE NATURE
OF ROLE-PLAYING ADVENTURE GAMES, TRAD-
ING CARDS, TRADING CARD MILK BOTTLE
CAPS, COLORING BOOKS, ADHESIVE STICKERS,
RUB-ON TRANSFERS, NOTEBOOKS AND STA-
TIONERY-TYPE PORTFOLIOS, IN CLASS 16 (U.S.
CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 1-29-1997; IN COMMERCE 1-29-1997.

FOR: CLOTHING, NAMELY, PAJAMAS, HATS
SWEATSHIRTS, T-SHIRTS, SHIRTS, SHOES, JACK-

ETS, SHORTS, SOCKS AND SWEATERS, IN CLASS
25 (U.S. CLS. 22 AND 39).

FIRST USE 12-13-1996; IN COMMERCE 12-31-1996.

FOR: COMPUTER SOFTWARE GAMES; HAND-
HELD UNITS FOR PLAYING ELECTRONIC
GAMES; TOYS, NAMELY, TOY ACTION FIGURES
AND ACTION FIGURE ACCESSORIES, IN CLASS 28
(U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 11-12-1996; IN COMMERCE 11-12-1996.

SN 75-983,307, FILED 4-26-1996.

GLENN CLARK, EXAMINING ATTORNEY

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,416,001

United States Patent and Trademark Office

Registered Dec. 26, 2000

**TRADEMARK
PRINCIPAL REGISTER**

DIABLO

DAVIDSON & ASSOCIATES, INC. (CALIFORNIA
CORPORATION)
19840 PIONEER AVENUE
TORRANCE, CA 90503

GAMES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND
38).

FIRST USE 11-12-1996; IN COMMERCE
12-30-1996.

SER. NO. 75-978,709, FILED 4-26-1996.

FOR: ENTERTAINMENT COMPUTER PROGRAMS
IN THE NATURE OF ROLE-PLAYING ADVENTURE

GLENN CLARK, EXAMINING ATTORNEY

U.S. Patent and Trademark Office (USPTO)

NOTICE OF ALLOWANCE

NOTE: If any data on this notice is incorrect, please fax a request for correction to the Intent to Use Unit at 571-273-9550. Please include the serial number of your application on ALL correspondence with the USPTO.

ISSUE DATE: May 8, 2007

ROD A. RIGOLE
VIVENDI UNIVERSAL GAMES, INC.
6060 CENTER DR FL 5
LOS ANGELES, CA 90045-1596

**** IMPORTANT INFORMATION: 6 MONTH DEADLINE ****

You filed the trademark application identified below based upon a bona fide intention to use the mark in commerce. You must use the mark in commerce and file a Statement of Use (a.k.a. Allegation of Use) before the USPTO will register the mark. You have six (6) MONTHS from the ISSUE DATE of this Notice of Allowance (NOA) to file either a Statement of Use, or if you are not yet using the mark in commerce, a Request for Extension of Time to File a Statement of use ("Extension Request"). If you file an extension request, you must continue to file a new request every six months until the Statement of Use is filed. Applicant may file a total of five (5) extension requests. FAILURE TO FILE A REQUIRED DOCUMENT DURING THE APPROPRIATE TIME PERIOD WILL RESULT IN THE ABANDONMENT OF YOUR APPLICATION.

Please note that both the "Statement of Use " and "Extension Request" have many legal requirements including fees. Therefore, we encourage use of the USPTO forms, available online at <http://www.uspto.gov/teas/index.html> (under "File a PRE-registration form"), to avoid the possible omission of important information. Please note that the Trademark Electronic Application System (TEAS) provides line-by-line help instructions for completing the Extension Request or Statement of Use forms online. If you do not have access to the Internet, you may call 1-800-786-9199 to request the printed form(s).

The following information should be reviewed for accuracy:

SERIAL NUMBER:	78/770575
MARK:	DIABLO (STANDARD CHARACTER MARK)
OWNER:	Blizzard Entertainment, Inc. 6060 Center Drive, 5th Floor Los Angeles , CALIFORNIA 90045

This application has the following bases, but not necessarily for all listed goods/services:

Section 1(a): NO	Section 1(b): YES	Section 44(e): NO
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GOODS/SERVICES BY INTERNATIONAL CLASS

041 -	ENTERTAINMENT SERVICES, NAMELY, PROVIDING ON-LINE COMPUTER AND VIDEO GAMES, ON-LINE PUBLICATIONS IN THE FIELD OF TIPS AND STRATEGIES FOR COMPUTER GAMES; ARRANGING AND CONDUCTING COMPUTER GAME COMPETITIONS; ENTERTAINMENT IN THE NATURE OF AN ONGOING TELEVISION PROGRAM IN THE FIELD OF CHARACTERS AND PLOTS BASED ON A VIDEO GAME; AND PRODUCTION AND DISTRIBUTION OF MOTION PICTURES -- FIRST USE DATE: NONE: -- USE IN COMMERCE DATE: NONE
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ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

ADDITIONAL INFORMATION MAY BE PRESENT IN THE USPTO RECORDS